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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/007,613 | 10/26/2001 | Jason C. H. Shih | 4171-102 CIP | 4213 |

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INTELLECTUAL PROPERTY / TECHNOLOGY LAW
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EXAMINER

LUCAS, ZACHARIAH

ART UNIT PAPER NUMBER

1648

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

221

Advisory Action

Application No.

10/007,613

Applicant(s)

H. SHIH, JASON C.

Examiner

Zachariah Lucas

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 35-51, 53-56, 63, 71, 73, 74, 80 and 82.

Claim(s) withdrawn from consideration: 68, 69 and 75-79.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8-30-04.
10. ☒ Other: See Continuation Sheet

Continuation of 3. Applicant's reply has overcome the following rejection(s): The amendments have overcome 1) the objection to the specification, 2) the objection to claim 60, 3) the rejection of claims 39-52, 56-61, 64, and 65 for scope of enablement regarding the temperature range that may be used for the sterilization of the articles, 4) the rejection of claims 64 and 65 for scope of enablement, and 5) the rejection of claims 56, 59, 71, 73, and 74 for containing New Matter to the application.

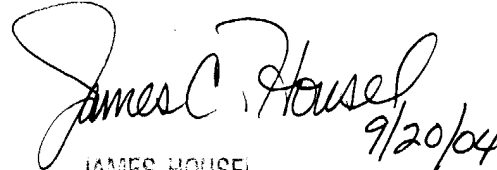
Continuation of 5. does NOT place the application in condition for allowance because:
The amendments have not overcome the objection to the claims as reading on systems for the treatment of articles that may be infected with prion proteins, wherein the systems are described as comprising the articles to be worked on. The Applicant has not responded to this objection other than to assert that the amendments to the claims have overcome the objection. Because the claims still read on the systems, and describe the articles to be worked upon by the systems as a part thereof, the objection is maintained.

The amendments have not overcome the rejections of the claimed systems for obviousness under 35 U.S.C. section 103(a). The Applicant traverses these rejections on the grounds that the cited references do not teach the recited temperatures and process in the claims. However, as was indicated in the prior action, the claims are directed to compositions of matter, and not to methods. Thus, these "limitations" are read as no more than an identification of intended use. There are no teachings demonstrating that the systems and kits suggested by the prior art would not be capable of performing the indicated functions (heating and treating the instruments to be sterilized). There has therefore been no demonstration that the kits or systems suggested in the prior art vary structurally from the claimed compositions. Because the compositions suggested by the art meet the structural limitations of the claims, and because a new method of use is not sufficient to overcome an art rejection on a composition, the arguments in traversal are not found persuasive. The rejection is therefore maintained against pending claims 39-51, 53-56, 63, 71, and 73 for the reasons of record and the reasons above.

Continuation of 10. Other: It is noted that the references cited in the IDS of August 30, 2004 have been crossed out on the listing. This is because the references were previously made of record and considered. See, the PTO form 892 mailed with the Final Action of 6-30-2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is 571-272-0905. The examiner can normally be reached on Monday-Friday, 8 am to 4:30 pm.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Z. Lucas
Patent Examiner


JAMES HOUSEL
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9/20/04